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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,606	09/18/2001	Ralph W. Wright	A148 1601	1143

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EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,606

Applicant(s)

WRIGHT ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,21-31 and 33-52 is/are pending in the application.
- 4a) Of the above claim(s) 21-30,42 and 45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39 is/are allowed.
- 6) ☒ Claim(s) 18,31,33-38,40,41,43,44 and 46-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is in response to the amendment received 2/17/04.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings were received on 2/17/04. These drawings are acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 49 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claim 49 requires "the backing... has a textured surface", and new claim 50 requires "the slurry is applied in a pattern onto the backing in such a manner that portions of the backing are free of solidified slurry." It is unclear where in the specification these limitations are described, and in particular that the backing has a textured surface and that the applied pattern includes portions free of slurry. Applicant has referred to page 1, lines 11 to 13, page 9, lines 3

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to 7, the carryover paragraph on pages 9 and 10, Example One and Two on pages 14 and 15, and Figures 1 and 4 for support. However, these parts of the specification do not disclose the limitations in claims 49 and 50, and in particular Examples 1 and 2 describe the non-elected method.

Claim Rejections - 35 USC § 103

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18, 31, 33, 35, 38, 43, 44, 46, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makoui et al. (U.S. Patent 6,173,49) in view of Sukenik (U.S. Patent 3,807,013).

Makoui et al. disclose embossing a paper product, i.e. a surface covering, by pressing an embossing roll (directly) into the paper product wherein the embossing roll comprises a mandrel having a removable sleeve thereon, the sleeve formed of for example fiber reinforced resin, such that by changing the sleeve the embossing pattern may be routinely changed at minimal expense, it being noted the removable sleeve taught by Makoui et al. may be used in a number of different embossing processes, i.e. recyclable, or again in the same process, i.e. reusable (Column 1, lines

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8-12 and Column 3, lines 22-24 and Column 7, lines 44-45 and Column 8, lines 52-60). Makoui et al. are silent as to any particular method for forming the fiber reinforced resin sleeve. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the fiber reinforced resin sleeve taught by Makoui et al. using any well known and conventional process such as that shown for example by Sukenik as only the expected results would be achieved.

Sukenik disclose forming a fiber reinforced resin sleeve for subsequent placement on a mandrel wherein the sleeve is formed by preparing a slurry of fibers (i.e. filler) and binder, applying the slurry to a cylindrical screen (i.e. a roll having a textured surface) (it being noted the applied slurry constitutes a "pattern"), and then drying (i.e. solidifying) the slurry (Column 2, lines 2-8, 15-28, and 58-60).

Regarding claim 50, it is noted Sukenik teaches the outside surface of the sleeve may be machined as desired such that absent any unexpected results it would have been obvious to one of ordinary skill in the art at the time the invention was made to machine the fiber reinforced sleeve taught by Makoui et al. as modified by Sukenik to have any desired embossing pattern as doing so would have required nothing more than ordinary skill and routine experimentation.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makoui et al. and Sukenik as applied to claims 18, 31, 33, 35, 38, 43, 44, 46, 49, and 50 above, and further in view of Grunthaler et al. (DE 3824292 and see also the English abstract).

Makoui et al. and Sukenik as applied above teach all of the limitations in claim 34 except for a specific teaching of screen printing the slurry onto the cylindrical screen. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the

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slurry taught by Makoui et al. as modified by Sukenik to the cylindrical screen using any well known and conventional method such as by screen printing as shown for example by Grunthaler et al. as Makoui et al. as modified by Sukenik are not limited to any particular method and only the expected results, i.e. that of applying the slurry, would be achieved.

Grunthaler et al. disclose the well known and conventional technique of applying a slurry comprising fibers and a binder to a substrate by screen printing (See the English abstract).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makoui et al. and Sukenik as applied to claims 18, 31, 33, 35, 38, 43, 44, 46, 49, and 50 above, and further in view of Radvan et al. (U.S. Patent 4,734,321).

Makoui et al. and Sukenik as applied above teach all of the limitations in claim 36 except for a specific teaching of using a biodegradable binder, it being noted Makoui et al. as modified by Sukenik do not suggest any particular binder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the binder taught by Makoui et al. as modified by Sukenik any well known and conventional binder in the art such as the biodegradable binder shown for example by Radvan et al. for the obvious environmental benefits.

Radvan et al. disclose forming fiber reinforced articles from a slurry comprising fibers and a binder wherein the binder may be starch (Column 2, lines 24-30 and Column 5, lines 7-8).

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10. Claims 18, 31, 33, 35, 37, 38, 40, 41, 43, 44, and 46-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Specification pages 1-3) in view of Makoui et al. and Sukenik.

The admitted prior art discloses methods for forming decorative laminate surface coverings, e.g. floor coverings. The admitted prior art teaches the surface coverings comprise a substrate, e.g. a felted or matted fibrous sheet of overlapping, intertwined filaments or fibers, covered with a substantially uniform layer of a gelled or cured resinous composition containing a synthetic polymeric material and a blowing or foaming agent. The admitted prior art teaches a texture/gloss may be mechanically embossed by pressing a pattern/texture into the surface covering, chemically embossed by using foam retarding agents to restrict expansion of the foamable layer in specific regions of the design, or both. The admitted prior art teaches the mechanical embossing comprises using embossing rolls which press against and into the surface covering under relatively great pressure to obtain a desired embossed decorative or textured surface. The admitted prior art teaches the embossed decorative texture may be in register with a printed design located on the surface covering (Page 1, lines 11-23 and Page 2, lines 1-10). The admitted prior art is silent as to the use of any particular embossing roll. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the embossing roll taught by the admitted prior art any well known and conventional embossing roll such as the one suggested by Makoui et al. (Makoui et al. is described in full detail in paragraph 7) as the embossing roll taught by Makoui et al. comprises a mandrel having a removable sleeve thereon, the sleeve formed of for example fiber reinforced resin, such that by simply changing the sleeve the embossing pattern may be routinely changed at minimal expense. It is noted

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Makoui et al. are silent as to any particular method for forming the fiber reinforced resin sleeve. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the fiber reinforced resin sleeve taught by the admitted prior art as modified by Makoui et al. using any well known and conventional process such as that shown for example by Sukenik (Sukenik is described in full detail in paragraph 7) as only the expected results would be achieved.

Regarding claim 50, it is noted Sukenik teaches the outside surface of the sleeve may be machined as desired such that absent any unexpected results it would have been obvious to one of ordinary skill in the art at the time the invention was made to machine the fiber reinforced sleeve taught by the admitted prior art as modified by Makoui et al. and Sukenik to have any desired embossing pattern as doing so would have required nothing more than ordinary skill and routine experimentation.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, Makoui et al., and Sukenik as applied to claims 18, 31, 33, 35, 37, 38, 40, 41, 43, 44, and 46-52 above, and further in view of Grunthaler et al.

The admitted prior art, Makoui et al., and Sukenik as applied above teach all of the limitations in claim 34 except for a specific teaching of screen printing the slurry onto the cylindrical screen. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the slurry taught by the admitted prior art as modified by Makoui et al. and Sukenik to the cylindrical screen using any well known and conventional method such as by screen printing as shown for example by Grunthaler et al. (Grunthaler et al. is described in full detail in paragraph 8) as the admitted prior art as modified by Makoui et al. and Sukenik are

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not limited to any particular method and only the expected results, i.e. that of applying the slurry, would be achieved.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makoui et al. and Sukenik as applied to claims 18, 31, 33, 35, 37, 38, 40, 41, 43, 44, and 46-52 above, and further in view of Radvan et al.

The admitted prior art, Makoui et al., and Sukenik as applied above teach all of the limitations in claim 36 except for a specific teaching of using a biodegradable binder, it being noted the admitted prior art as modified by Makoui et al. and Sukenik do not suggest any particular binder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the binder taught by the admitted prior art as modified by Makoui et al. and Sukenik any well known and conventional binder in the art such as the biodegradable binder shown for example by Radvan et al. (Radvan et al. is described in full detail in paragraph 9) for the obvious environmental benefits.

Allowable Subject Matter

13. Claim 39 is allowed.

14. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a method of embossing an article comprising applying a recyclable and reusable slurry in a pattern to a backing, solidifying the slurry, pressing the slurry into an article, removing the slurry from the backing and article, and then reclaiming the slurry.

Response to Arguments

15. Applicant's arguments with respect to claims 18, 31, 33-38, 40, 41, 43, 44, and 46-52 have been considered but are moot in view of the new ground(s) of rejection. It is noted the rejection is made Final in view of applicants amendment to claim 18. The rejections over Brenot et al. (U.S. Patent 5,569,419) are withdrawn in favor of Makoui et al., Sukenik, and the admitted prior art. Applicants arguments were drawn to Brenot et al. and are now moot in view of the withdrawal of Brenot et al. and the new rejections.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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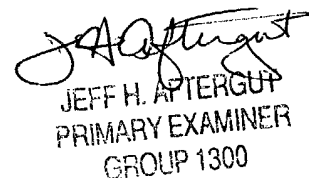
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John L. Goff
May 6, 2004



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